

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

67108-351PUS1;Lee 2-1-3

CERTIFICATE OF FACSIMILE

I hereby certify that this Pre-Appeal Brief Request For Review and Notice of Appeal are being facsimile transmitted to (571) 273-8300.

on _____

Signature _____

Typed or printed
name _____

Application Number

10/602,146

Filed

6/24/2003

First Named Inventor

Hoyong Lee

Art Unit

2175

Examiner

Nunez, Jordany

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒

attorney or agent of record.

Registration number 37,139

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



Signature

David J. Gaskey

Typed or printed name

(248) 988 8360

Telephone number

July 28, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.☒

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application: Lee, Hoyong Group Art Unit: 2175
Serial No.: 10/602,146 Examiner: Nunez, Jordany
Filed: June 24, 2003 Confirmation No.: 9878
For: WEB-BASED USER INTERFACE FOR PERFORMING
PROVISIONING

Box AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Applicant respectfully requests pre-appeal brief review of the final rejection of claims 3, 4, 14, 15, 20 and 21 because there is no *prima facie* case of obviousness.

The Examiner rejects those claims on a "nonfunctional descriptive material" basis but that cannot apply to the claims in this case because the very cases cited by the Examiner indicate that such a rejection is not applicable to this case. Therefore, the rejection of those claims must be withdrawn.¹

Claims 3 and 4 depend from claim 1. Those three claims are reproduced here for convenience:

1. One or more computer-readable media comprising computer executable instructions that, when executed, direct a computer to:
display Web-based pages on a display device, each Web-based display page comprising: a first area containing a graphical workflow indicator that provides an ordered list of user-selectable tasks associated with performing provisioning hardware resources in order to organize said computer hardware resources into a network, wherein provisioning hardware resources comprises configuring physical links or service

¹ Only claims 3, 4, 14, 15, 20 and 21 are on appeal. If the decision responsive to this request is to withdraw the rejection against those claims, Applicant is willing to rewrite those claims as independent claims to secure allowance of this application.

channels among network elements; and

a second area containing at least one of display information and parameter fields associated with a particular one of the user-selectable tasks, such that when a particular one of the user-selectable tasks is selected from the first area, the at least one of the information and parameter fields necessary to complete operations associated with the particular one of the user-selectable tasks are presented in the second area.

3. One or more computer-readable media as recited in Claim 1, wherein the graphical workflow indicator includes a numeric indicator that specifies (i) which user-selectable task is currently selected by the user, and (ii) where within the ordered list the user-selectable task falls.

4. One or more computer-readable media as recited in Claim 1, wherein the display information includes a map of a network.

Claims 14 and 15 are system claims having corresponding limitations and claims 20 and 21 are method claims having corresponding limitations.

When rejecting the claims on appeal, the Examiner suggests that the admitted differences between the claims and the references are only “nonfunctional descriptive material.” When making the rejection, the Examiner relies upon case law that is inapposite to this case. The *In re Gulack* and *In re Lowry* cases cannot be used to support the rejection made by the Examiner. In fact, they dictate that the rejection cannot be made.

The *In re Lowry* decision, for example, makes it clear that such a nonfunctional descriptive material rejection is inappropriate for a case such as this. As explained by the Court of Appeals for the Federal Circuit, “The printed matter cases have no factual relevance where ‘the invention as defined by the claims *requires* that the information be processed not by the mind but by a machine, the computer.’” *In re Lowry*, 32 USPQ 2d, 1031, 1034 (Fed. Cir. 1994). (Emphasis in original) In other words, when the information at issue is processed by a computer, there is no basis for a rejection such as that used against the claims on appeal.

Clearly, the claims in this case pertain to information processed by a computer. The graphical workflow indicator of claims 3, 14 and 20 is displayed by a computer. The display information map of claims 4, 15 and 21 is displayed by a computer. Therefore, the claim limitations that the Examiner admits are not found in the references are processed by a machine in the context of the claims. It follows that the rejections of those claims is without basis and must be withdrawn. The Court of Appeals for the Federal Circuit has clearly stated that the rejections on appeal are improper.

The Examiner has suggested that since a numeric indicator or a map of a network are eventually interpreted by an individual or by the human mind, that somehow brings the claims under the purview of a printed matter rejection. The claims are not focused on the eventual interpretation that an individual may or may not make of the numeric indicator or map. Instead, claims 3 and 4 focus on the computer readable medium that stores instructions for a computer to display the indicator or map, claims 14 and 15 focus on a system including a processor configured to execute computer-executable instructions for displaying the numeric indicator or map and claims 20 and 21 focus on a method of displaying the numeric indicator or map. The displaying of the claims is done by the computer and that is done separate from any interpretation by an individual. The Examiner's rationale for the rejection is not consistent with the claim language or the case law.

**The rejection of claims 3, 14 and 20
must be withdrawn.**

The Examiner cannot apply a "non-functional descriptive material" rejection to any of claims 3, 14 or 20. The Examiner suggests that the numeric indicator of claims 3, 14 and 20 is non-functional descriptive material. Given that claims 3, 14 and 20 all require

operation by a computer, a printed matter or non-functional descriptive material rejection cannot be made in this case. Additionally, Applicant's claimed limitations are more than non-functional descriptive material. Either way, the rejection must be withdrawn. There is no *prima facie* case of obviousness against these claims because, as the Examiner admits, the art does not teach all the limitations of the claims.

**The rejection of claims 4, 15 and 21
must be withdrawn.**

As explained above, a non-functional descriptive material rejection cannot be made in this case. The very Federal Circuit precedent that the Examiner relies upon for making this rejection explains why such a rejection cannot be made in this case. There is no *prima facie* case of obviousness against any of claims 4, 15 or 21 and the rejection must be withdrawn.

Conclusion

The Examiner has to withdraw the rejections of claims 3, 4, 14, 15, 20 and 21. There is no basis for making those rejections in this case. Applicant respectfully submits that the claims on appeal are allowable.

Respectfully submitted,

CARLSON, GASKEY & OLDS, P.C.



David J. Gaskey
Registration No. 37,139
400 West Maple, Suite 350
Birmingham, MI 48009
Telephone: (248) 988-8360

Date: July 29, 2009